The opinion in support of the decision being entered today was <u>not</u> written for publication in a law journal and is <u>not</u> binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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<u>Ex parte</u> D. MICHAEL BELL

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Appeal No. 2000-1598
Application No. 08/934,968

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ON BRIEF

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MAILED

APR 1 5 2003

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before HAIRSTON, KRASS and JERRY SMITH, <u>Administrative Patent Judges</u>.

KRASS, <u>Administrative Patent Judge</u>.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-10.

The invention is directed to bus systems within a computer. More particularly, it involves the embedding of control information in the bus system.

Independent claim 1 is representative and is reproduced as follows:

-1-

1. A method for dynamically sending device data in a bus
transaction comprising the steps of:

a first device generating a request comprising a plurality
of fields including a device configurable field comprising device
configurable data;

said first device issuing the request to a second device;

said second device generating a reply comprising a plurality
of fields;

said second device copying the data received in the device
configurable field into a designated field of the plurality of
fields of the reply;

said second device issuing the reply to the first device.

The examiner relies on the following references:

Ward	5,448,708	Sep. 05,	1995
Glassen et al. (Glassen)	5,671,441	Sep. 23,	1997
		(filed Nov. 29,	1994)

Claims 1-10 stand rejected under 35 U.S.C. 103 as

unpatentable over Ward in view of Glassen.

Reference is made to the briefs and answer for the

respective positions of appellant and the examiner.

OPINION

The examiner takes the position that Ward discloses a first

device 88 and a second device 100, wherein the first device

issues a request, comprising a device control/data field, to the

second device, the second device generating and issuing a reply

which is a copy of the data received from the first device. The

examiner turns to Glassen for a teaching of the data field

including a device configuration field, referring to column 5,

line 65 through column 6, line 31, and finds that it would have

been obvious to have combined Glassen with Ward "because it would

provide the dynamical configuration for device in the computer

system" [answer-page 3].

Appellant's position is that Ward does not disclose a first

device issuing a request to a second device with the second

device issuing a reply to the first device, as claimed.

Appellant points out that Ward is concerned with a shared memory

connected between a sending unit 102 and a receiving unit 108 and

that no requests containing a device configurable field

containing data written into by the first device, or replies

containing a copy of the data received in the device configurable

field of the request are generated or used.

The examiner's response is to argue that Ward has a client

entry 202 (a first device) sending a request to a server entity

208 (a second device) "by placing the request control element

204...wherein the request control element 204 contains a format

identifier, a length field, common indicators field, source and

destination fields, a correlation field and an entity-to-entity field that varies length...; the server 208 (i.e. second device) generates the control element 216 (i.e. reply) which contains (i.e. copies) the data into the control element 216 along with the fields..." [answer-page 4].

We have reviewed the many arguments of appellant and the examiner, along with the other evidence of record and we conclude therefrom that the examiner has not established a prima facie case of obviousness. Accordingly, we will not sustain the rejection of claims 1-10 under 35 U.S.C. 103.

Initially, we note that Ward does not disclose the claimed request wherein one of the fields in the plurality of fields in the request is "a device configurable field comprising device configurable data." The examiner recognized this deficiency and employed Glassen to provide the deficiency in Ward.

However, the examiner points to column 5, line 65 through column 6, line 31, of Glassen for the teaching of a device configuration field. Reference to that portion of Glassen reveals a plurality of fields for each entry of a table of I/O channel path identifiers. Also, contents of certain fields are associated with a programmable subchannel in a channel subsystem. While the plurality of fields in Glassen may be used to determine

which channel path and I/O device address will be used when an instruction specifying a programmable subchannel is issued by the computer program, this does not appear to suggest a "device configurable field comprising device configurable data," as claimed, because the fields and configuration data records of Glassen are not part of a request, including configuration data, issued by a first device or a reply issued by a second device. Rather, the fields and configuration data records of Glassen are merely parts of a main memory and a table of I/O channel path identifiers, as argued by appellant at page 8 of the principal brief. Thus, appellant appears to be correct in the assessment that Glassen does not disclose a device configurable field.

Furthermore, while we understand that the examiner relies on Ward for the communication between the first and second devices, even if we agreed, arguendo, that Glassen discloses a field specifying device configurable data, we are at a loss to determine what possible motive an artisan would have had in using any such teaching of a field specifying device configurable data in Ward in order to establish the instant claimed subject matter.

The examiner says that the combination would have been obvious because "it would provide the dynamical configuration for device in the computer system" [answer-page 3]. We do not

understand what this means but, in any event, the examiner's rationale clearly falls far short of a cogent rationale as to why the artisan would have sought to combine any of the teachings of Ward with those of Glassen and, accordingly, no prima facie case of obviousness of the instant claimed subject matter has been shown by the examiner.

Moreover, we are unconvinced that Ward even discloses the second device "copying" the data received in the device configurable field into a designated field of the plurality of fields of the reply. The examiner identifies Figure 1 and column 4, lines 11-30, of Ward for the teaching of a second device 208 generating a reply (control element 216) which contains, i.e., "copies" the data into the control element 216 along with fields. Our review of that portion of Ward reveals no "copying," as claimed.

In short, we agree with appellant that the combination of Ward and Glassen would not teach or suggest "a first device issuing a request comprising a plurality of fields including [a] device configurable field to a second device, and the second device issuing a reply comprising a plurality of fields, one of which contains a copy of the data located in the device

configurable field of the request to the first device" [reply

brief-page 7].

The examiner's decision rejecting claims 1-10 under

35 U.S.C. 103 is reversed.

<div align="center">REVERSED</div>

KENNETH W. HAIRSTON)
Administrative Patent Judge)
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ERROL A. KRASS)   BOARD OF PATENT
Administrative Patent Judge)   APPEALS AND
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